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09/991,679	11/26/2001	Steven Parker	WH 11 264-1US	4166
24962	7590	09/17/2004	EXAMINER	
DENNISON ASSOCIATES 133 RICHMOND STREET WEST SUITE 301 TORONTO, ON M5H 2L7 CANADA			PAULA, CESAR B	
			ART UNIT	PAPER NUMBER
			2178	
DATE MAILED: 09/17/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/991,679

Applicant(s)

PARKER ET AL.

Examiner

CESAR B PAULA

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to the application filed on 11/26/2001.

**This action is made Non-Final.**

2. Claims 1-25 are pending in the case. Claims 1, and 21 are independent claims.

#### ***Priority***

3. It is noted, that applicant has not filed certified copies of the Canadian application number 2,351,780 as required by 35 U.S.C. 119(b). Therefore, the priority claim has been denied.

#### ***Drawings***

4. The drawings filed on 11/26/2001 have been approved by the examiner.

#### ***Claim Objections***

5. Claim 16 is objected to because of the following informalities: "an advertisement partial selected". It appears that this should read as "an advertisement partially selected" instead.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8 recites "said gift certificate is attached as a third panel of a two panel greeting card" in lines 1-3. It is unclear how a greeting card which only has two panels can also have a third panel.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon et al, hereinafter Cannon (Pat.# 5,552,994, 9/3/1996), in view of Endo et al, hereinafter Endo (USPub. # 2002/0022989, filed on 2/21/2002, filed on 2/22/2002).

Regarding independent claim 1, Cannon discloses accessing databases—*server*-- over a network to order personalize greeting cards. The databases are categorized and have a list of

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images of card designs associated with parameters, such as friend, recipient, graphic design, artwork media, etc., --*categorized expressions*—(col.4, lines 31-60, and col.7, lines 3-34).

Moreover, Cannon discloses the compression of the greeting card images when a minimum amount of memory is to be used --*form a reduced portion of each database*—(to personalize the greeting card(s) (col.8, lines 57-65).

Moreover, Cannon discloses that a user is allowed to select the parameter and card design --*categorized expressions*—to personalize the greeting card(s), which have images and text (col.4, lines 29-67).

Moreover, Cannon discloses the printing of the ordered personalized greeting card(s), along with a mailing envelope and mailing address of a recipient—*delivery arrangement for delivering the printed greeting card* (col.4, lines 60-67, col.5, lines 30-40, and col.17, lines 3-12). Cannon fails to explicitly disclose: *associating the customized greeting card a related sale or promotion*. However, Endo teaches the printing of a greeting card and advertisement information related to products and services which might be of interest to the recipient (0054, and 0115). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Cannon, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

Regarding claim 2, which depends on claim 1, Cannon discloses the printing of the ordered personalized greeting card(s), along with a mailing envelope and mailing address of a recipient (col.17, lines 3-12).

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Regarding claim 3, which depends on claim 1, Cannon discloses the printing of the ordered personalized greeting card(s), along with a mailing envelope and mailing address of a recipient (col.4, lines 60-67, col.5, lines 30-40, and col.17, lines 3-12). Cannon fails to explicitly disclose: *customized greeting is associated with a sale of a gift product*. However, Endo teaches the printing of a greeting card and advertisement information related to products and services-- *a sale of a gift product greeting card*-- which might be of interest to the recipient (0054, and 0115). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Cannon, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

Regarding claim 4, which depends on claim 1, Cannon discloses the printing of the ordered personalized greeting card(s), along with a mailing envelope and mailing address of a recipient (col.4, lines 60-67, col.5, lines 30-40, and col.17, lines 3-12). Cannon fails to explicitly disclose: *greeting card is associated with an advertisement of a party different from the manufacturer of the card*. However, Endo teaches a consumer printing the greeting card and advertisement information related to products and services of businesses-- *a party different from the consumer or manufacturer of the card*-- which might be of interest to the recipient (0053-0054, and 0115). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Cannon, and Endo, because Endo teaches the benefit of improving the

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publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

Regarding claim 5, which depends on claim 4, Cannon discloses the printing of the ordered personalized greeting card(s), along with a mailing envelope and mailing address of a recipient (col.4, lines 60-67, col.5, lines 30-40, and col.17, lines 3-12). Cannon fails to explicitly disclose: *said advertisement is a sales promotion*. However, Endo teaches a consumer printing the greeting card and advertisement information related to products and services-- *a sales promotion*-- of businesses which might be of interest to the recipient (0053-0054, and 0115). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Cannon, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

Regarding claim 6, which depends on claim 1, Cannon discloses accessing databases, for picking images over a network to order personalize greeting cards. The databases are categorized and have a list of publishers' images of card designs associated with parameters, such as friend, recipient, graphic design, artwork media, etc., (col.4, lines 31-60, and col.7, lines 3-34). Cannon fails to explicitly disclose: *customized greeting card is associated with a gift certificate delivered with the card*. However, Endo teaches sending a greeting card along with a coupon for a free trial of a new song—*gift certificate* (0054, and 0137, 0141-0144, fig.27). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Cannon,

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and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

Regarding claim 7, which depends on claim 6, Cannon discloses accessing databases, for picking images over a network to order personalize greeting cards. The databases are categorized and have a list of publishers' images of card designs associated with parameters, such as friend, recipient, graphic design, artwork media, etc., (col.4, lines 31-60, and col.7, lines 3-34). Cannon fails to explicitly disclose: *said gift certificate is attached to said card*. However, Endo teaches sending a coupon attached to the greeting card for a free trial of a new song—*gift certificate* (0054, and 0137, 0141-0144, fig.27). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Cannon, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

Regarding claim 8, which depends on claim 7, Cannon discloses accessing databases, for picking images over a network to order personalize greeting cards. The databases are categorized and have a list of publishers' images of card designs associated with parameters, such as friend, recipient, graphic design, artwork media, etc., (col.4, lines 31-60, and col.7, lines 3-34). Cannon fails to explicitly disclose: *said gift certificate is attached as a third panel of a two panel greeting card*. However, Endo teaches sending a coupon attached, in the back portion of the card which has two sides, to the greeting card for a free trial of a new song—*gift certificate* (0054, and 0137, 0141-0144, fig.27). It would have been obvious to a person of ordinary skill in



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the art at the time of the invention to combine Cannon, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

Regarding claim 9, which depends on claim 1, Cannon discloses the printing of the ordered personalized greeting card(s), along with a mailing envelope and mailing address of a recipient (col.4, lines 60-67, col.5, lines 30-40, and col.17, lines 3-12). Cannon fails to explicitly disclose: *a gift is sent with said card and said gift is selected using said website*. However, Endo teaches sending a greeting card along with a coupon-- *gift*—using a website over the Internet (0012-0013, and 0054). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Cannon, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

Regarding claim 10, which depends on claim 1, Cannon discloses the printing of the ordered personalized greeting card(s), along with a mailing envelope and mailing address of a recipient (col.4, lines 60-67, col.5, lines 30-40, and col.17, lines 3-12). Cannon fails to explicitly disclose: *said greeting card and the delivery thereof are free to said user*. However, Endo teaches sending a greeting card along with a coupon-- *gift*—using a website over the Internet free to the sender (0006, 0012-0013, and 0054). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Cannon, and Endo, because Endo teaches

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the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

Regarding claim 11, which depends on claim 1, Cannon discloses the printing of the ordered personalized greeting card(s), along with a mailing envelope and mailing address of a recipient (col.4, lines 60-67, col.5, lines 30-40, and col.17, lines 3-12). Cannon fails to explicitly disclose: *a cost of manufacture of said greeting card is partially funded by said associated sale or promotion*. However, Endo teaches providing greeting cards for free, when an advertiser is allowed to place ads in the greeting cards (0054, 0107-0109, 0119). In other words the ads replace the cost of producing the greeting cards, except—*partially*-- for the costs involved in providing the computer, and Internet connection used to access the website to produce the greeting cards. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Cannon, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0009-0006).

Regarding claim 12, which depends on claim 11, Cannon discloses the printing of the ordered personalized greeting card(s), along with a mailing envelope and mailing address of a recipient (col.4, lines 60-67, col.5, lines 30-40, and col.17, lines 3-12). Cannon fails to explicitly disclose: *said website includes advertisements viewed when using said website*. However, Endo teaches displaying and sending over the Internet, greeting cards with advertisements and coupons attached, in the back portion of the card which has two sides, to the greeting card for a free trial

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of a new song (0054, and 0137, 0141-0144, fig.26-28). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Cannon, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0009-0006).

Regarding claim 13, which depends on claim 9, Cannon discloses the printing of the ordered personalized greeting card(s), along with a mailing envelope and mailing address of a recipient (col.4, lines 60-67, col.5, lines 30-40, and col.17, lines 3-12). Cannon fails to explicitly disclose: *based on user provided information makes a series of recommendations of appropriate gifts available using said website*. However, Endo teaches allowing a sending user to select addressee attributes for determining advertisement information, and coupon geared towards the addressee's interest (0054, and 0141-0146). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Cannon, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0009-0006).

Regarding claim 14, which depends on claim 1, Cannon discloses a list of card designs associated with parameters, such as the intended card recipient, graphic design style, the sending occasion, interests of the intended recipient, etc.,--*expressions categorized by occasion* —(col.4, lines 31-60, and col.7, lines 3-34).

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Regarding claim 15, which depends on claim 1, Cannon discloses listing or categorizing images with card designs using parameters, such as the intended card recipient, graphic design style, the sending occasion, interests of the intended recipient, etc.,--*expressions used as part of categorization of said images*—(col.4, lines 31-60, and col.7, lines 3-34)

Regarding claim 16, which depends on claim 1, Cannon discloses the printing of the ordered personalized greeting card(s), along with a mailing envelope and mailing address of a recipient (col.4, lines 60-67, col.5, lines 30-40, and col.17, lines 3-12). Cannon fails to explicitly disclose: *said sale or promotion is an advertisement partial selected based on the information entered by the user*. However, Endo teaches allowing a sending user to select addressee attributes, and the website to selecting advertisement information, and coupon thought to be thought to be geared towards the addressee's interest (0054, and 0141-0146). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Cannon, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0009-0006).

Regarding claim 17, which depends on claim 1, Cannon discloses the printing of the ordered personalized greeting card(s), along with a mailing envelope and mailing address of a recipient (col.4, lines 60-67, col.5, lines 30-40, and col.17, lines 3-12). Cannon fails to explicitly disclose: *website includes a database of advertisers and related criteria used to pair an advertisement with an appropriate customized greeting card*. However, Endo teaches databases for storing advertisers, and advertisement information associated with those advertisers, for

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providing information thought to be of interest to a recipient (0054, 0060). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Cannon, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0009-0006).

Regarding claim 18, which depends on claim 17, Cannon discloses the printing of the ordered personalized greeting card(s), along with a mailing envelope and mailing address of a recipient (col.4, lines 60-67, col.5, lines 30-40, and col.17, lines 3-12). Cannon fails to explicitly disclose: *the cost of advertisement paired to a greeting card is used to subsidize the cost of the greeting card charged to the user*. However, Endo teaches providing greeting cards for free, when an advertiser is allowed to place ads in the greeting cards (0054, 0107-0109, 0119). In order words the ads subsidize the cost of producing the greeting cards, except for the costs involved in providing the computer, and Internet connection used to access the website to produce the greeting cards. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Cannon, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0009-0006).

Regarding claim 19, which depends on claim 1, Cannon discloses the printing of the ordered personalized greeting card(s), along with a mailing envelope and mailing address of a recipient (col.4, lines 60-67, col.5, lines 30-40, and col.17, lines 3-12). Cannon fails to explicitly disclose: *a database of corporate marketing information*. However, Endo teaches a database for

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storing advertisers and businesses' advertisement information for providing information thought to be of interest to a recipient (0054, 0060). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Cannon, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0009-0006).

Regarding claim 20, which depends on claim 1, Cannon discloses databases for storing categories of expressions, and images for publishers of the greeting card(s) (col.4, lines 34-67, col. 7, lines 3-12).

Regarding independent claim 21, Cannon discloses accessing databases—*server--* over a network to order personalize greeting cards. The databases are categorized and have a list of publishers' images of card designs associated with parameters, such as friend, recipient, graphic design, artwork media, etc., —*corporate communication associated with a particular client—* (col.4, lines 31-60, and col.7, lines 3-34). Cannon fails to explicitly disclose: *a database containing a series of marketing communications associated with the wares and/or services of the corporation.* However, Endo teaches the printing of a greeting card and advertisement information related to products and services of the businesses, which might be of interest to the recipient (0054, and 0060). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Cannon, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

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Moreover, Cannon discloses a user inputting parameters to pick the category of the publishers cards—*corporate communications*-- to be displayed to the user over a computer network (col.4, lines 31-67, and col.7, lines 3-34). Cannon fails to explicitly disclose: *at least one marketing communication associated with the wares and/or services of the corporation*. However, Endo teaches the printing of a greeting card and advertisement information related to products and services of the businesses, which might be of interest to the recipient (0054, and 0060). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Cannon, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

Moreover, Cannon discloses the transmission of the selected card to a printing facility (col.4, lines 50-67).

Furthermore, Cannon discloses the printing of the ordered personalized greeting card(s), along with a mailing envelope and mailing address of the recipient—*address associated with client information* (col.4, lines 60-67, col.5, lines 30-40, and col.17, lines 3-12).

Regarding claim 22, which depends on claim 21, Cannon discloses a database for including numbers and codes on the personalized cards for identifying the publishers of these cards—*corporate communications are divided to be specific to a particular corporation* (col.4, lines 3-35). Cannon fails to explicitly disclose: *said series of marketing communications are divided to be specific to a particular corporation*. However, Endo teaches databases for including businesses and their associated advertising information for the printing of a greeting

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card and advertisement information related to products and services of the businesses, which might be of interest to the recipient (0054, and 0060). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Cannon, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

Regarding claim 23, which depends on claim 22, Cannon discloses numbers and codes on cards for identifying the publishers of these cards (col.4, lines 3-35).

Regarding claim 24, which depends on claim 21, Cannon discloses creating and printing greeting cards (col.1, lines 15-21, and col.4, lines 50-67).

Regarding claim 25, which depends on claim 24, Cannon discloses accessing databases, for picking images over a network to order personalize greeting cards. The databases are categorized and have a list of publishers' images of card designs associated with parameters, such as friend, recipient, graphic design, artwork media, etc., —*corporate communication associated with a particular client*— (col.4, lines 31-60, and col.7, lines 3-34).



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***Conclusion***

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McCarthy (Pat. # 2004/0015404), Spector (Pat. # 5,870,718), Moeller (Pat. # 6,691,871), and Rubstein et al. (Pat. # 2003/0061566).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543 (571) 272-2148 as of 10/12/04. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (703) 308-5465 ( (571) 272-4124 as of 10/12/04). However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Or faxed to:

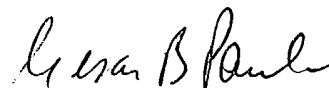
- (703) 703-872-9306, (for all Formal communications intended for entry)

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**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Sixth Floor (Receptionist).**

A handwritten signature in cursive script, appearing to read "Cesar B Paula".

CESAR B PAULA  
Patent Examiner  
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9/16/04